

REMARKSClaim Objections – 35 U.S.C. § 112

The Office Action objected to claims 1-33 for failing to explicitly recite the phrase ‘unmanned aerial vehicle.’ Independent claims 1, 12, and 23 have been amended to explicitly recite the phrase ‘unmanned aerial vehicle.’ As such, the rejection should be withdrawn.

Claim Rejections – 35 U.S.C. § 112

Claims 12, and 23 stand rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement. The Office Action fails to state a prima facie case of inadequate written description under 35 U.S.C. § 112. The Office Action states, “claims 12 and 23 are rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement.” The Office Action alleges the particular failures of the written description requirement of the element “means for piloting the UAV.” The legal requirements for a prima facie case of inadequate written description are set forth in MPEP 2163 I A which states, “There is a strong presumption that an adequate written description of the claimed invention is present when the application is filed. *In re Wertheim*, 541 F.2d 257, 263, 191 USPQ 90, 97 (CCPA 1976) ...” The court in *Wertheim* said, among other things, “... the PTO has the initial burden of presenting evidence or reasons why persons skilled in the art would not recognize in the disclosure a description of the invention defined by the claims.”

In addition, MPEP 2163 III A states “A description as filed is presumed to be adequate, unless or until sufficient evidence or reasoning to the contrary has been presented by the examiner to rebut the presumption. See.e.g., *In re Marzocchi*, 439 F.2d 220, 224, 169 USPQ 367, 370 (CCPA 1971). MPEP also states “...the examiner must set forth express findings of fact ... [and] (B) Establish a *prima facie* case by providing reasons why a person skilled in the art at the time the application was filed would not have recognized

that the inventor was in possession of the invention as claimed in view of the disclosure of the application as filed.”

The Office Action states no reasons why persons skilled in the art would not recognize in the disclosure a description of “means for piloting the UAV.” Instead the Office Action states only:

That description is: “means for piloting the UAV” (a low level block as “Piloting the UAV to the way point in accordance with a navigation algorithm – 410” in Figure 4 or, “Co-pilot.TM.. from FMA” in para. [0060] is not proper for a claimed feature of “means for piloting.”

The rejection is deficient for at least two reasons. The first reason that the rejection is deficient is that the rejection does not state why the cited sections are considered to be the description in the specification of “means for piloting the UAV.” The second reason that the rejection is deficient is that the rejection does not state why persons skilled in the art would not recognize a description of “means for piloting the UAV” from this cited section of the application. Without more the rejection should be withdrawn. Applicants respectfully request reconsideration of claims 12 and 23.

Claim Rejections – 35 U.S.C. § 103

Claims 1, 12, and 23 stand rejected as being unpatentable over Applicant Admitted Prior Arts (AAPAs) in view of Delorme *et al.* (U.S. Patent No. 5, 986, 604). U.S. Patent No. 5, 986, 604 is actually issued to Nichols *et al.* Applicants presume that the citation of Delorme is a typographical error. The rejection is deficient because the rejection does not articulate any section in either Applicant Admitted Prior Arts (AAPAs) or Delorme that teaches a single element of the claims. Instead of making a reference to any of the actual claim elements of claims 1, 12, and 23, the Office Action states only:

AAPAs teach about remotely controlling an UAV; the applicants also show a disadvantage of the prior art is the use of a camera to control an UAV (see the specification, the background portion).

However, Delorme et al. teach about not using a camera to guide an object with a computer screen (GUI) map pixel to Earth's coordinates that represents a waypoint for navigation, the pixel having a location on the computer screen (GUI) see Delorme et al. Fig. 2 and col.30, lines 19-25, and col. 37 lines 8-12).


That is, the Office Action merely characterizes Applicants' background and alleges that some other reference discloses a deficiency in that characterization. A characterization of Applicants' background and an allegation that another reference (5, 986, 604) discloses some deficiency in that characterization of the background simply cannot support a prima facie case of obviousness. To establish a prima facie case of obviousness, three basic criteria must be met. *Manual of Patent Examining Procedure* §2142. The first element of a prima facie case of obviousness under 35 U.S.C. § 103 is that the proposed combination of AAPAs and U.S. Patent No. 5, 986, 604 must teach or suggest all of Applicants' claim limitations. *In re Royka*, 490 F.2d 981, 985, 180 USPQ 580, 583 (CCPA 1974). The second element of a prima facie case of obviousness under 35 U.S.C. § 103 is that there must be a suggestion or motivation to combine the AAPAs and U.S. Patent No. 5, 986, 604. *In re Vaeck*, 947 F.2d 488, 493, 20 USPQ2d 1438, 1442 (Fed. Cir. 1991). The third element of a prima facie case of obviousness under 35 U.S.C. § 103 is that there must be a reasonable expectation of success in the proposed combination of AAPAs and U.S. Patent No. 5, 986, 604. *In re Merck & Co., Inc.*, 800 F.2d 1091, 1097, 231 USPQ 375, 379 (Fed. Cir. 1986). The Office Action does not establish a prima facie case of obviousness because the Office Action fails to demonstrate as single requirement of a prima facie case of obviousness. That is, the Office Action fails to mention a single element of any claim in rejecting claims 1, 12, and 23 and therefore does not demonstrate in any way how the proposed combination of AAPAs and U.S. Patent No. 5, 986, 604 teach or suggest all of Applicants' claim limitations. The Office Action also fails to cite any suggestion or motivation to combine the AAPAs and U.S. Patent No. 5, 986, 604. The Office Action also fails to illustrate any reasonable expectation of success in the proposed combination of AAPAs and U.S. Patent No. 5, 986, 604. As such, the Office Action does not establish a prima facie case of obviousness and the rejection should be withdrawn.

The Commissioner is hereby authorized to charge or credit Deposit Account No. 09-0447 for any fees required or overpaid.

Respectfully submitted,

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